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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/675,688 | 09/29/2000 | Ashraf A. Michail | MSI-675US | 1484 |
| 22801 | 7590 | 10/10/2006 | EXAMINER | |
| LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201 | | | STORK, KYLE R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2178 | |

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,688

Applicant(s)

MICHAEL ET AL.

Examiner

Kyle R. Stork

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 23-28 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 23-28 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This non-final office action is in response to the Appeal Brief filed 26 June 2006.
2. Claims 1-6, 23-28, and 36-41 are pending. Claims 1, 23, and 36 are independent claims. The rejection of claims 1-6, 23-28, and 36-41 under 35 USC 103 under Walkowski (10 Minute Guide to WordPerfect 5.1 for Windows, 1992) in view of Pensak et al. (US 6289450) has been withdrawn.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Section 2100 of the MPEP states:

b) Nonfunctional Descriptive Material

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

Office personnel should be prudent in applying the foregoing guidance. Nonfunctional

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descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

As per claims 1-6, "a selection services component" is not directed to statutory subject matter. The claims therefore fail to meet the requirements of U.S.C. 101, and are subsequently rejected.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson (Mastering WordPerfect® 5.1 & 5.2 For Windows™, 1993).

As per independent claim 1, Simpson discloses in an extensible electronic document editor, a selection services component comprising a selection services interface that provides one or more methods to enable an editor extension to override a selection function provided by the electronic document editor and provide a customized model for the selection function (pages 512, 514, and 517-518: Here a user overrides an existing macro provided by the electronic document editor by overwriting the pre-

existing macro), and to clear, add or remove a segment from a selection object using the customized model for the selection function (pages 517-518 and 520: Here, a user is able to edit a macro by clearing the macro and overwriting or by adding/removing a segment from the macro).

As per dependent claim 2, Simpson discloses wherein one of the methods provided further comprises a method that adds an element to an editable selection (pages 517-518 and 520).

As per dependent claim 3, Simpson discloses wherein the selection services interface is adapted to enable the extensible electronic document editor to interact with the customized selection model without exposing details of the editor extension (page 516-517: Here, when a macro is executed, the user does not see the actually keystrokes/coding of the macro. Instead the user merely has the resulting document).

As per dependent claim 4, Simpson discloses wherein one of the methods further comprises a method that adds a segment to an editable selection (pages 523-525: Here, a user is able to edit the text of the macro similarly to editing a text document).

As per dependent claim 5, Simpson discloses wherein one of the methods further comprises a method that removes a segment from an editable selection (pages 523-525).

As per dependent claim 6, Simpson discloses wherein one of the methods further comprises a method that sets a selection type (pages 526-535: Here, macros can be of a plurality of types, including automatic execution, automatic execution at start-up, and nested).

As per independent claims 23, Simpson discloses a computer-readable medium having computer-executable instructions for one or more interfaces that, when executed by an extensible electronic document editor on a computer, perform the following steps:

- Override a selection function provided by the electronic document editor to provide a customized model for the selection function (pages 512, 514, and 517-518)
- Receive parameters from a designer through a selection services interface (pages 512-513: Here, the creation of a macro enters parameters from a designer through a selection services interface)
- Utilize the parameters to clear, add, or remove a selected segment from a selection object of an electronic document using the customized model for the selection function (pages 517-518 and 520)
- Return values to the designer regarding the state of the selected segment (pages 514-515: Here, a designer recording a macro is presented with a macro definition that has recorded all the keystrokes while creating the macro)

As per dependent claims 24-28, the applicant discloses the limitations similar to those in claims 2-6 respectively. Claims 24-28 are similarly rejected.

As per independent claim 36, the applicant discloses the limitations similar to those in claims 1 and 23. Claim 36 is similarly rejected.

As per dependent claims 37-41, the applicant discloses the limitations similar to those in claims 2-6 respectively. Claims 37-41 are similarly rejected.

Response to Arguments

6. Applicant's arguments with respect to claims 1-6, 23-28, and 36-41 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyle R Stork
Patent Examiner
Art Unit 2178


CESAR PAULA
PRIMARY EXAMINER